

Remarks

Entry of the amendment is respectfully requested. No new matter has been added.

Reconsideration is respectfully requested.

Claim Status

Claims 1-34 are pending in the Application. Claims 35-38 have been added.

Claims 2-6, 8-26, and 28-34 were indicated allowable over the prior art if written in an independent form. The Examiner's early indication of allowable subject matter is greatly appreciated.

Claims 1, 7 and 27 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication US 2003/0089769 A1 to Jantsch.

The Claim Amendments

The subject matter of original claim 2 has been included in newly added independent claim 35. Claim 3 has been amended to depend from claim 35.

The subject matter of original claim 8 has been included in newly added independent claim 36.

The subject matter of original claim 12 has been included in newly added independent claim 37.

The subject matter of original claim 23 has been included in newly added independent claim 38. Claims 24 and 25 have each been amended to depend from claim 38.

Thus, it is respectfully submitted that claims 3-6, and 9-11, 13-22 and 24-38 are in condition for allowance.

35 U.S.C. § 103 Rejections: The Applicable Legal Standards

The Office has the responsibility to present a *prima facie* case of obviousness under 35 U.S.C. § 103. An Applicant is entitled to a patent if the Office fails to establish a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q. 2d 1443 9Fed. Cir. 1992). In determining obviousness under 35 U.S.C. § 103, the invention must be considered “as a whole.”

Any modification of the cited reference in order to arrive at Applicant’s invention must be motivated by the cited art. *In re Deminski*, 230 U.S.P.Q. 313 (Fed. Cir. 1986). Applicant’s own disclosure may not serve as a template to piece together the teachings of the prior art to render the claimed invention obvious. *In re Fitch*, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). There must be a reason or suggestion in the prior art for selecting the claimed procedure, other than knowledge learned from Applicant’s disclosure. *In re Dow Chemical*, 5 U.S.P.Q. 2d 1529 (Fed. Cir. 1988). Further, the motivation for modifying a reference cannot be found if the reference actually “teaches away” from the claimed invention. *In re Gurley*, 31 U.S.P.Q. 2d 130 (Fed. Cir. 1994).

The rejections of claims 1, 7 and 27 are traversed.

Claim 1

Claim 1 recites “a transport adapted to move items between an opening in the housing wherein items in the opening are accessible from outside the machine, and at least one item storage area in the housing ...including a generally smooth platen surface including a curved

portion; and “at least one movable belt flight biased toward engagement with the curved portion of the platen surface, wherein items are moved ... in sandwiched relation between the at least one belt flight and the curved portion of the platen surface.” It is respectfully submitted that the cited reference fails to meet the requirements of claim 1.

The Examiner mischaracterizes Applicants’ claim as requiring the platen to include a movable curved portion and further mischaracterizes certain elements of the cited reference. The claim requires a platen having a curved portion. In rejecting the claim, the Examiner states:

“The transport path [of the reference] includes a curved portion 54 which may be rotated to a plurality of positions.” This statement not only implies that the claimed curved portion of the platen must be movable, it does not even accurately reflect the teachings of the reference.

Curved surface 54 (of the reference) is stationary and is accessible by movement of hinged door 181 in the event of a jam (Para. 0075). Dispensing rollers 58, are rotatable on shaft 60 and serve to engage the bills to be dispensed and move them toward the outlet 20 (Para. 0045). In the reference, the elements responsible for movement of the bills to be dispensed (dispensing rollers 58) extend through the curved surface 54. In other words, the curved surface 54 and the moving means (rollers 58) are disposed on the same side of a dispensed bill.

The Examiner further states: “The curve portion is effected by the spring-bias 56.” Again, the Examiner mischaracterizes the reference. Control vane 56, although movable, is not biased toward the curved portion of the smooth platen surface. On the contrary, control vane 56 is biased toward a position to reject bills (i.e. away from the surface 54) and must be driven to the dispense position adjacent surface 54. (Para. 0044). Additionally, the control vane 56 does not

provide impetus to the bills to be dispensed. Movement of the bills is caused by the dispensing rollers 58 which extend through the curved surface 54.

Further, the Examiner's statement that "Jantsch does not specifically disclose that the curved portion is a belt" reveals another mischaracterization of the claim. The platen surface includes the claimed *curved portion*. The curved portion is not claimed as part of the movable belt flight.

Expanding on this mischaracterization, the Examiner opines that vane 54 [*sic*] is a functional equivalent to the belt flight. However, control vane 56 cannot be a functional equivalent to the claimed belt flight, since control vane 56 does not provide impetus to the bills to be dispensed. According to the teachings of the reference, the bills are moved by engagement with dispense rollers 58 which extend through curved surface 54. Control vane 56 merely interrupts the transport path and does not operate to move the bills.

Curved surface 54 cannot be a functional equivalent to the claimed belt flight, as the reference does not teach or suggest that it is movable, as noted above.

Further, Applicants' claim requires that "items are moved ... in sandwiched relation between the at least one belt flight and the curved portion of the platen surface." In other words, the items are sandwiched between a movable element that causes the items to be transported (belt flight) and a curved portion of a support surface (platen). The Examiner's modification and interpretation of the cited reference fails to provide this claim limitation, since the reference clearly teaches that the curved surface 54 and the dispense rollers 58 are disposed *on the same side* of a dispensed bill.

Claim 1 also recites that the transport is “adapted to move items between an opening in the housing...and at least one item storage area in the housing.” The reference clearly teaches movement of bills from a money box (storage area) to a dispensing opening. Thus, this limitation of claim 1 is not met.

In view of the above comments, when taken as a whole, claim 1 is not obvious in view of the reference. Claim 1 has thus been shown to be allowable over the cited reference. As such it is respectfully requested that the rejection of claim 1 be withdrawn.

Claim 7

Claim 7 depends from claim 1, which has been shown to be allowable over the cited art. In addition, claim 7 recites at least one aperture in the curved portion, wherein at least one support roll extends in the at least one aperture. The reference teaches dispensing rollers 58 that extend through the curved surface 54. The dispensing rollers drive the movement of the bills to be dispensed. (Para. 0045, Fig. 2). Claim 7 recites the recited feature of claim 1 in that the belt flight operates to transport the items. There is no teaching or suggestion in the reference itself that would motivate one of skill in the art to modify the reference so that the rollers extending through the curved surface are opposed to a movable member that drives the bills. Thus, claim 7 is shown to be allowable over the cited reference.

Claim 27

Claim 27 depends from claim 1 and includes all the features thereof. Thus, it is submitted that claim 27 is allowable over the cited reference. Claim 27 recites the additional

feature that the transport includes an extension portion, wherein the extension portion is releasibly engageable with the transport, and wherein the extension portion includes a portion of the platen surface.

The Examiner states : “when the curved portion is rotated upward (see figure 2), the new path can be considered ‘releasibly engaged’ (since the path can revert back towards 20).” This statement reveals another mischaracterization both of the teachings of the cited reference and Applicants’ claim. It is an *extension portion* that is releasibly engageable with the transport and the extension portion *includes a portion of the platen surface*. To assist the Examiner, attention is directed to pages 59-62 of Applicants’ specification and Figures 42-44. Further, claim 27 retains the feature that *items are moved between the opening (in the housing) and the at least one storage area*. In accordance with the teachings of the reference, if control vane 56 is rotated to establish the Examiner’s “new path,” then bills are directed to move from the money box (16) to the rejected bill collection box (52), which does not satisfy the requirements of the claim.

Other claims:

Original claims 2, 8, 12, and 23 each ultimately depend from claim 1. Claim 1 has been shown to be allowable over the cited reference. As such it is respectfully requested that the rejection of claims 2, 8, 12 and 23 be withdrawn.

Additional Comments

Applicant has not necessarily presented all of the reasons as to why the cited reference does not provide the claimed invention. Nevertheless, Applicant’s remarks herein have shown

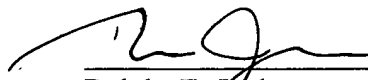
that when the invention is taken as a whole, the cited reference does not teach or suggest the claimed invention. The Office has therefore failed to provide a *prima facie* case of obviousness within the meaning of 35 U.S.C. § 103(a). Thus, it is respectfully submitted that the rejections should be withdrawn.

Conclusion

Each of Applicants' pending claims specifically recite features and relationships that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any such teaching, suggestion, or motivation for modifying features of the applied art so as to produce Applicant's invention. Allowance of all of Applicant's pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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